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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91252817
Party	Plaintiff House of Kuipers, LLC
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Date	10/01/2020
Attachments	Response to Boards Motion to Substitute Parties.pdf(89542 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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**IN THE MATTER OF TRADEMARK SERIAL NO. 88/228,839**

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HOUSE OF KUIPERS LLC, a California  
limited liability company, et al.,

Opposer,

v.

JOHN ZOX, an Individual,

Applicant.

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) **Opposition No. 91252817**

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) **RESPONSE TO BOARD’S MOTION TO  
SUBSTITUTE PARTIES**

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Zox, LLC (“Assignee”) hereby files this brief in response to the Trademark Trial and Appeal Board’s (“the Board”) conversion of Assignee’s Notice of Change of Ownership to a motion to substitute parties, i.e. “the Board’s Motion.”

**I. INTRODUCTION**

On June 17, 2020, Assignee’s predecessor, House of Kuipers, LLC (“HOK”), filed a “Notice of Change of Ownership” as to its relied upon Registrations Nos. 4,412,948; 4,465,691; 4,759,961 and 5,233,845 (collectively, the “Registrations”). (*See* Docket Entry No. 18). HOK advised that Board that it had “assigned all rights, title and business good will” in the registrations to Assignee. (*Id.* at ¶2). HOK recorded a Trademark Assignment Agreement with the Assignment Services Branch of the USPTO on May 22, 2020 at Reel/Frame 6945/0227. A copy of the assignment was attached as Exhibit A to the Notice of Change of Ownership. (*Id.* at ¶5).

On September 3, 2020, the Board, on its own accord, converted HOK's Notice of Change of Ownership to a Motion to Substitute Parties ("the Board's Motion") and suspended this proceeding. (*See* Docket Entry No. 19.)

On September 23, 2020, Applicant filed an opposition to the Board's Motion. (*See* Docket Entry No. 21.)

## **II. LEGAL STANDARD**

When there has been an assignment of a mark that is the subject of, or relied upon in, an *inter partes* proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative. *TBMP* § 512.01 (2020). When the assignment is recorded in the Assignment Recordation Branch of the USPTO, the assignee may be substituted as a party. Substitution is proper if the assignment occurred prior to the commencement of the proceeding, the assignor is no longer in existence, the opposing party raises no objections, or the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery. *Id.* *See also, NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1031 (TTAB 2014) (finding joinder rather than substitution appropriate where assignment of the pleaded mark was executed one year after proceeding commenced and nothing in the record indicated the petitioner or business connected with mark was no longer in existence).

## **III. DISCUSSION**

The facts relevant to the Board's motion are as follows: (1) the assignment of HOK's relied upon registrations to Assignee occurred on May 14, 2020, or after the commencement of this action on December 10, 2019; (2) the discovery and testimony periods in this proceeding remain open, (*see* Docket Entry No. 13); (3) Assignee's predecessor, HOK, remains active and continues its business operations; and, (4) Applicant objects to the substitution. (*See* Docket Entry No. 21.)

Based upon the above facts and prevailing authority, the relevant factors weigh against substitution and in favor of joinder. Thus, Assignee contends that the Board should join Assignee, i.e. Zox, LLC, to this action and that HOK should remain a party for discovery purposes.

Respectfully submitted,

Date: October 1, 2020

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Predecessor, HOUSE OF KUIPERS, LLC

## **CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing RESPONSE TO MOTION TO SUBSTITUTE PARTIES was served upon the attorney for John Zox, by electronic mail only, to DARREN GELIEBTER, deliebter@lgtrademarklaw.com, on the date given below.

Date: October 1, 2020

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